

BEST AVAILABLE COPY

Appl. No. : 09/641,591
Filed : August 18, 2000

III. REMARKS

Claims 1-54 are pending in this application. In the Office Action mailed April 22, 2005, the Examiner rejects all the claims. In particular, the Examiner rejects Claims 1-6, 9-14 and 23-54 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner rejects Claims 1-26, 33, 35, 41 and 43-54 under 35 U.S.C. § 103(a) as being unpatentable over the reference entitled "Effects of Placement and Orientation of Body-Fixed Accelerometers on the Assessment of Energy Expenditure During Walking," by Bouten et al. ("Bouten") in view of U.S. Patent No. 4,657,003 to Wirtz ("Wirtz"), and in further view of U.S. Patent No. 5,533,531 to Edwards et al. ("Edwards"). The Examiner also rejects Claims 28-32, 34 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Bouten in view of Wirtz patent, and in further view of Edwards and U.S. Patent No. 5,734,421 to Maguire, Jr. ("Maguire"). Furthermore, the Examiner rejects Claim 42 under 35 U.S.C. § 103(a) as being unpatentable over Bouten in view of Wirtz and in further view of Edwards and U.S. Patent No. 6,183,259 to Marci et al. ("Marci").

As of this Response, Applicant has amended Claims 6, 9-11, 14 and 26. Claims 1-5, 7, 8, 12, 13, 15-25 and 27-54 remain as originally filed or as previously pending. In view of the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration of Claims 1-54 and submits that Claims 1-54 are in condition for allowance.

A. STATUS OF APPLICATION

The Summary Sheet of the April 22, 2005 Office Action indicates that the Office Action was a not a final action. However, the heading of Section II (page 3) of the April 25, 2005 Office Action indicates that the claim rejections were final. In response to a telephone call by Applicant's Attorney of Record, Arthur S. Rose, Examiner Tom Stevens indicated on April 29, 2005, that the April 22, 2005 Office Action is non-final.

B. DENIAL OF REQUESTS FOR EXAMINER INTERVIEW

In an effort to expedite the prosecution of the subject patent application and in response to the new grounds for rejection raised in the third Office Action, Applicant

Appl. No. : 09/641,591
Filed : August 18, 2000

BEST AVAILABLE COPY

twice submitted (i.e., on April 28, 2005, and May 19, 2005) a request for an Examiner interview. Copies of each of these requests are attached at the end of this Response.

The first request was denied by Examiner Thomas Stevens, who indicated that the issues raised in the third Office Action had already been discussed with the Applicant. Examiner Stevens also indicated that his current docket did not allow him enough time to discuss the new art rejections with Applicant. Applicant never received a response from the Examiner with respect to the second request.

Because Applicant disagrees with the Examiner and believes that new bases for rejections have been raised by the Examiner in the third Office Action, Applicant's undersigned attorney of record hereby formally requests, pursuant to M.P.E.P. § 713.01, a telephone interview with the Examiner. Applicant's attorney can be reached at (949) 721-2814 or at the general office number listed below.

C. REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

1. The Word "System" Is Used In The Claims Of Over A Half Million Patents And Is Cited With Approval By The M.P.E.P.

The Examiner rejects Claims 1-5, 10-14 and 23-54 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner rejects the use of the term "system" as being "ambiguous and indefinite by not defining which statutory type (i.e., apparatus or machine) the claims are declaring."

Applicant respectfully traverses the Examiner's rejection and submits that the use of the term "system" does not render Claims 1-5, 10-14 and 23-54 indefinite. The term "system" is found in each of the preambles of the above-identified claims, and Applicant notes that the M.P.E.P. repeatedly refers to the term "system" as being used in the preamble of a claim (see, e.g., §§ 601.01(f), 608.02, 2131, 2143.01). Furthermore, Applicants also note that "system" is a commonly-used and accepted claim term, as is evidenced by the occurrence of the term "system" in claims of at least 550,000 patents issued in the last 30 years.

In view of the foregoing, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. § 112, second paragraph, as to the use of the term "system" in Claims 1-5, 10-14 and 23-54. If the Examiner maintains this

Appl. No. : **09/641,591**
Filed : **August 18, 2000**

rejection, Applicant respectfully requests the Examiner to provide the reasoning and legal basis behind such a rejection, as well as an example of how the Examiner believes this rejection can be overcome.

2. Use Of The Phrase "Such That"

The Examiner rejects Claims 6, 9-11, 14 and 26 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner rejects the use of the phrase "such that" because "it is unclear whether the claim limitations following the phrase are part of the claimed invention."

Applicant respectfully traverses the Examiner's rejection and submits that the use of the phrase "such that" does not render Claims 6, 9-11, 14 and 26 indefinite. Per se rules of indefiniteness are improper, and the test for definiteness "is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification'" (see, e.g., M.P.E.P. § 2173.02). As indicated in M.P.E.P. § 2173.05(g), such language, which defines an element by what it does, "does not, in and of itself, render a claim improper." Therefore, Applicant submits that such claim language sets definite boundaries on the patent protection sought and that one with ordinary skill in the art would understand the scope of the claims.

However, in an effort to expedite prosecution of this Application, Applicant has amended Claims 6, 9-11, 14 and 26 to clarify the recited subject matter. Applicant submits that such amendments do not narrow the claims, and no acquiescence or estoppel is or should be implied thereby.

In view of the foregoing, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. § 112, second paragraph, and Applicant submits that Claims 6, 9-11, 14 and 26 are in condition for allowance.

D. REJECTION OF CLAIMS 1-54 UNDER 35 U.S.C. § 102(e)

1. It Would Not Have Been Obvious To Combine A Motion Detector With A Cast

The Examiner rejects Claims 1-26, 33, 35, 41 and 43-54 under as being unpatentable over Bouten in view of Wirtz, and in further view of Edwards. The Examiner also rejects Claims 28-32, 34 and 40 as being unpatentable over Bouten in

Appl. No. : 09/641,591
Filed : August 18, 2000

view of Wirtz, and in further view of Edwards and Maguire. Furthermore, the Examiner rejects Claim 42 as being unpatentable over Bouten in view of Wirtz, and in further view of Edwards and Marci.

The Examiner's baseline position is that it would have been obvious to combine a motion detection system (Bouten) with a cast (Wirtz) and an electronic alignment system (Edwards) to teach the claimed invention. First of all, the cited references have nothing to do with the claimed invention. For example, Claim 1 recites "a sensory feedback device which provides a sensation to the user corresponding to the motion which occurs in the simulated environment."

Furthermore, there is no basis in law, in fact or in common sense to combine a motion detector with a cast. Additionally, even if one could combine a motion detector with a cast, it is entirely unclear what the result of such a combination would be. Finally, irrespective of what the resulting combination might be, the invention disclosed and claimed is not contemplated or taught by any of the cited references, whether taken alone or taken in combination.

2. Independent Claims 1, 6, 10, 15, 23, 45 and 52

With respect to independent Claims 1, 6, 10, 15, 23, 45 and 52, the Examiner combines Bouten, Wirtz and Edwards to form the basis of the rejection under 35 U.S.C. § 103(a). For at least the reasons set forth below, Applicant respectfully traverses this rejection and the Examiner's characterization of the cited references.

In general, Bouten appears to disclose the use of sensors to register accelerations in order to measure the frequency and intensity of movements during physical activity (see page 50, para. 1). Wirtz, on the other hand, appears to disclose an immobilizing bag/envelope for restraining a body portion or a limb for the purpose of "reducing or minimizing injury . . . by reducing freedom of movement" (see column 1, lines 10-17). Edwards appears to be related to a man-machine interface that can be used to measure the range of motion of joints (see column 3, lines 31-33) and that includes an electronic alignment function (see column 5, lines 45 and 46).

Applicant respectfully submits that there is no reason or motivation to form a combination of a cast having motion sensors. Neither the prior art references

BEST AVAILABLE COPY

Appl. No. : 09/641,591
Filed : August 18, 2000

themselves, nor the knowledge of persons with ordinary skill in the art, nor the nature of the problem addressed by the claimed invention provides for a motivation to combine a cast with motion sensors (see M.P.E.P. 2143.01 stating also that "the prior art must suggest the desirability of the claimed invention"). In particular, Applicant was unable to find any suggestion in Bouten for combining its motion sensors with a cast, nor was Applicant able to find any suggestion in Wirtz to combine its cast with motion sensors. Furthermore, even if one was to combine motion sensors with a cast, it is unclear how the cited references could be combined to produce a useful result.

In addition, the Examiner impermissibly relies on references that are not analogous prior art to the Applicant's claimed subject matter (see M.P.E.P. § 2141.01(a)) and impermissibly combines such references. In particular, Bouten discloses the use of acceleration sensors and Wirtz discloses the use of an electronic alignment system, both of which are used to measure movement of at least one joint. Wirtz, on the other hand, is directed to a cast-like device used to immobilize portions of the body.

It is also not sufficient for the Examiner to apply hindsight to piece together prior art to show the teaching of Applicant's invention. It is not permissible to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985); See also M.P.E.P. § 2145(X)(A).

Furthermore, Applicant submits that the combination of references cited by the Examiner does not teach or disclose every element of independent Claims 1, 6, 10, 15, 23, 45 and 52. In particular, the identified portions of the references cited by the Examiner do not appear to relate to subject matter recited in the rejected claims. The following discussion identifies examples of elements of independent Claims 1, 6, 10, 15, 23, 45 and 52 that are not taught or suggested by the specific portions of the references cited by the Examiner.

BEST AVAILABLE COPY

Appl. No. : 09/641,591
Filed : August 18, 2000

a. Claim 1

With respect to the rejection of Claim 1, the Examiner cites Table 1 on page 54 of Bouten as teaching a "sensory feedback device which provides a sensation to the user." However, this table reveals data relating to energy expenditure and acceleration measurements (both measured and uncorrected values) during a certain walking velocity.

b. Claim 6

With respect to the rejection of Claim 6, the Examiner cites page 50, right column, lines 5-11 of Bouten for reciting "vibrating devices." This section, however, describes attaching accelerometers to portions of a human body.

c. Claim 10

With respect to the rejection of Claim 10, the Examiner cites Table 1 on page 54 of Bouten as teaching "vibrating devices located adjacent to a particular muscle to provide feedback indicating that the restricted portion of the user's body is moving." However, this table reveals data relating to energy expenditure and acceleration measurements (both measured and uncorrected values) during a certain walking velocity.

d. Claim 15

With respect to the rejection of Claim 15, the Examiner cites Table 1 on page 54 of Bouten as teaching "providing sensory feedback which is [a] reflection of [an] intended motion." However, this table reveals data relating to energy expenditure and acceleration measurements (both measured and uncorrected values) during a certain walking velocity.

e. Claim 23

With respect to the rejection of Claim 23, the Examiner cites page 50, right column, second paragraph, of Bouten for reciting "presenting [an] effect in the simulated environment to the user via the output system." This section, however, relates to various sources of a body-fixed accelerometer output and the sources relation to physical activity.

BEST AVAILABLE COPY

Appl. No. : **09/641,591**
Filed : **August 18, 2000**

f. Claim 45

With respect to the rejection of Claim 45, the Examiner cites column 7, lines 7–29 of Edwards for disclosing “provid[ing] sensations which mimic the sensation which would be felt if the attempted motion had occurred.” This section, however, relates to the use of an inner liner 70 between a patient and the patient’s garment (e.g., a data glove).

g. Claim 52

With respect to the rejection of Claim 52, the Examiner cites the title of Wirtz for teaching the “detecting of forces by the immobilized portion of the user’s body against the immobilizing device.” The title of Wirtz, however, is “IMMOBILIZER DEVICE” and does not appear to have anything to do with detecting forces.

h. Summary

In view of the foregoing, Applicant submits that the combination of Bouten, Wirtz, and Edwards is improper and, furthermore, that it is unclear how these references would be combined. In addition, even if the references were combined, the combination fails to teach or suggest every element of Independent Claims 1, 6, 10, 15, 23, 45 and 52, and Applicant respectfully requests that the rejection of Claims 1, 6, 10, 15, 23, 45 and 52 be withdrawn.

3. Dependent Claims

a. Claims 2–5

Claims 2–5, which depend from Claim 1 and include all the limitations of Claim 1, are believed to be patentable for the same reasons stated above with respect to Claim 1 and because of the additional limitations set forth therein. In addition, Applicant respectfully traverses the rejection of each of Claims 2–5 and the Examiner’s characterization of the cited references as applied to Claims 2–5. Since the cited references fail to teach or suggest every element of each of Claims 2–5, Applicant respectfully requests that the rejection of Claims 2–5 be withdrawn.

BEST AVAILABLE COPY

Appl. No. : 09/641,591
Filed : August 18, 2000

b. Claims 7-9

Claims 7-9, which depend from Claim 6 and include all the limitations of Claim 6, are believed to be patentable for the same reasons stated above with respect to Claim 6 and because of the additional limitations set forth therein. In addition, Applicant respectfully traverses the rejection of each of Claims 7-9 and the Examiner's characterization of the cited references as applied to Claims 7-9. Since the cited references fails to teach or suggest every element of each of Claims 7-9, Applicant respectfully requests that the rejection of Claims 7-9 be withdrawn.

c. Claims 11-14

Claims 11-14, which depend from Claim 10 and include all the limitations of Claim 10, are believed to be patentable for the same reasons stated above with respect to Claim 10 and because of the additional limitations set forth therein. In addition, Applicant respectfully traverses the rejection of each of Claims 11-14 and the Examiner's characterization of the cited references as applied to Claims 11-14. Since the cited references fail to teach or suggest every element of each of Claims 11-14, Applicant respectfully requests that the rejection of Claims 11-14 be withdrawn.

d. Claims 16-22

Claims 16-22, which depend from Claim 15 and include all the limitations of Claim 15, are believed to be patentable for the same reasons stated above with respect to Claim 15 and because of the additional limitations set forth therein. In addition, Applicant respectfully traverses the rejection of each of Claims 16-22 and the Examiner's characterization of the cited references as applied to Claims 16-22. Since the cited references fail to teach or suggest every element of each of Claims 16-22, Applicant respectfully requests that the rejection of Claims 16-22 be withdrawn.

e. Claims 24-26, 33, 35, 41, 43, and 44

Claims 24-26, 33, 35, 41, 43, and 44, which depend from Claim 23 and include all the limitations of Claim 23, are believed to be patentable for the same reasons stated above with respect to Claim 23 and because of the additional limitations set forth therein. In addition, Applicant respectfully traverses the rejection of each of Claims 24-26, 33, 35, 41, 43, and 44 and the Examiner's characterization of the cited references

Appl. No. : **09/641,591**
Filed : **August 18, 2000**

as applied to Claims 24–26, 33, 35, 41, 43, and 44. Since the cited references fail to teach or suggest every element of each of Claims 24–26, 33, 35, 41, 43, and 44, Applicant respectfully requests that the rejection of Claims 24–26, 33, 35, 41, 43, and 44 be withdrawn.

f. Claims 28–32, 34, and 40

Claims 28–32, 34, and 40, which depend from Claim 23 and include all the limitations of Claim 23, are believed to be patentable for the same reasons stated above with respect to Claim 23 and because of the additional limitations set forth therein. In addition, Applicant respectfully traverses the rejection of each of Claims 28–32, 34, and 40 and the Examiner's characterization of the cited references as applied to each of Claims 28–32, 34, and 40. In particular, the addition of Maguire to the combination of references still does not teach or suggest every limitation of each of Claims 28–32, 34, and 40.

Since the cited references fail to teach or suggest every element of each of Claims 28–32, 34, and 40, Applicant respectfully requests that the rejection of Claims 28–32, 34, and 40 be withdrawn.

g. Claim 42

Claim 42, which depends from Claim 23 and include all the limitations of Claim 23, are believed to be patentable for the same reasons stated above with respect to Claim 23 and because of the additional limitations set forth therein. In addition, Applicant respectfully traverses the rejection of Claim 42 and the Examiner's characterization of the cited references as applied to Claim 42. In particular, the addition of Marci to the combination of references still does not teach or suggest every limitation of Claim 42.

Since the cited references fail to teach or suggest every element of Claim 42, Applicant respectfully requests that the rejection of Claim 42 be withdrawn.

h. Claims 46–51

Claims 46–51, which depend from Claim 45 and include all the limitations of Claim 45, are believed to be patentable for the same reasons stated above with respect to Claim 45 and because of the additional limitations set forth therein. In addition,

Appl. No. : 09/641,591
Filed : August 18, 2000

Applicant respectfully traverses the rejection of each of Claims 46-51 and the Examiner's characterization of the cited references as applied to Claims 46-51. Since the cited references fail to teach or suggest every element of each of Claims 46-51, Applicant respectfully requests that the rejection of Claims 46-51 be withdrawn.

i. Claims 53 and 54

Claims 53 and 54, which depend from Claim 52 and include all the limitations of Claim 52, are believed to be patentable for the same reasons stated above with respect to Claim 52 and because of the additional limitations set forth therein. In addition, Applicant respectfully traverses the rejection of each of Claims 53 and 54 and the Examiner's characterization of the cited references as applied to Claims 53 and 54. Since the cited references fail to teach or suggest every element of each of Claims 53 and 54, Applicant respectfully requests that the rejection of Claims 53 and 54 be withdrawn.

IV. CONCLUSION

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved.

Also, please charge any additional fees, including any fees for additional extension of time or credit overpayment, to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 7/22/05

By: 

Arthur S. Rose
Registration No. 28,038
Attorney of Record
Customer No. 20,995
(949) 760-0404

1807418
071105

BEST AVAILABLE COPY

COPY

US P

Approved for use through 07/31/2006. OMB 0661-0031
US D P R N F R

Applicant Initiated Interview Request Form

Application No.: 09/641,591 First Named Applicant: Philip Rosedale
 Examiner: Thomas Stevens Art Unit: 2123 Status of Application: Pending - 3rd OA

Tentative Participants:

(1) Examiner Stevens (2) Arthur S. Rose(3) Christian A. Fox (4) _____Proposed Date of Interview: 5/2 - 5/5 Proposed Time: _____ (AM/PM)

Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video ConferenceExhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: _____

COPY

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rej. 112</u>	<u>1-5, 10-14</u> <u>23-54</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) <u>Rej. 103 (a)</u>	<u>1, 5</u>	<u>Bouten, Edwards</u> <u>Wirtz</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/> Continuation Sheet Attached					

Brief Description of Arguments to be Presented:
see attached sheet

An interview was conducted on the above-identified application on _____.

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature

Examiner/SPE Signature

Typed/Printed Name of Applicant or Representative

Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

COPY

Brief Description of Topics for Discussion:

- I. Applicants request assistance in understanding the reasoning and legal basis for the Examiner's rejection under 35 U.S.C. § 112, 2nd paragraph, of the preamble term "system" as being ambiguous and indefinite.
- II. Applicants request assistance in understanding how the Examiner intends to combine the following cited references to teach the claimed invention.
 - 1) "Effects of Placement and Orientation of Body-Fixed Accelerometers on the Assessment of Energy Expenditure During Walking" by Bouten et al.
 - 2) U.S. Patent No. 4,657,003 to Wirtz
 - 3) U.S. Patent No. 5,533,351 to Edwards et al.

1687003
042805

BEST AVAILABLE COPY

COPY

USP

PTOL-413A (08-04)
Approved for use through 07/31/2006. OMB 0851-0031
USDP R N F R

Applicant Initiated Interview Request Form

Application No.: 09/641,591 First Named Applicant: Philip Rosedale
 Examiner: Thomas Stevens Art Unit: 2123 Status of Application: Pending - 3rd OA

Tentative Participants:

(1) Examiner Stevens (2) Arthur S. Rose
 (3) Christian A. Fox (4) _____

Proposed Date of Interview: _____ Proposed Time: _____ (AM/PM)

Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rej. 112</u>	<u>1-5, 10-14</u> <u>23-54</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) <u>Rej. 103(a)</u>	<u>1, 5</u>	<u>Bouten, Edwards</u> <u>Wirtz</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Continuation Sheet Attached

Brief Description of Arguments to be Presented:
see attached sheet

An interview was conducted on the above-identified application on _____.

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature

Examiner/SPE Signature

Typed/Printed Name of Applicant or Representative

Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, 118 Patent and Trademark Office, 118 Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS

BEST AVAILABLE COPY

COPY

**REVISED REQUEST FOR INTERVIEW ON TWO ENTIRELY NEW BASES
OF REJECTION**

Applicants appreciate the first interview granted by the Examiner on January 4, 2005, after the second Office Action and believe that this interview contributed to advance the prosecution of this application. Pursuant to M.P.E.P. § 713.01(III), Applicants request an interview with the Examiner to clarify two entirely new issues raised in the Examiner's third Office Action so that a "mutual understanding" may be developed between Applicants and the Examiner. In particular, Applicants request further clarification of the following issues:

I. Objection to commonly-used word "system" (used in the claims of at least 550,000 issued U.S. patents)

The repeatedly refers to the term "system" as being used in claims (see, for example, M.P.E.P. §§ 601.01(f), 608.02, 2131, 2143.01). Thus, Applicants request clarification regarding the reasoning and legal basis for the Examiner's rejection under 35 U.S.C. § 112 (2nd paragraph) of the term "system."

II. Entirely new references: We need help identifying "the suggestion or motivation" to combine the new references

M.P.E.P. § 2143.01 indicates that if the proposed combination or modification of references would cause the prior art invention to be "modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Thus, Applicants request assistance in understanding where is the Examiner's suggestion to combine the use of motion sensors (Bouten et al.) with an arm cast (Wirtz). Furthermore, it would be helpful to the Applicants if the Examiner would provide some understanding as to how the electronic alignment system of Edwards et al. is related to the claimed subject matter of the present application.

1717926: 051805

COPY

BEST AVAILABLE COPY